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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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11/01/2001

Robert Eric Montgomery

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04/19/2006

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EXAMINER

JAGOE, DONNA A

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/039,935	Applicant(s) MONTGOMERY, ROBERT ERIC	
	Examiner Donna Jagoe	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 56-65 and 67-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 56-65 and 67-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) (2 Nov 2004; 3 Feb 2006)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/2/04 & 2/2/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

The amendment filed February 3, 2006 has been received and entered. Claims 56, 57, 70 and 71 have been amended and new claims 76 and 77 have been added.

Claims 56-65 and 67-77 are pending in this application.

Information Disclosure Statement

The information disclosure statements filed on November 2, 2004 and February 3, 2005 have been reviewed and considered. See enclosed copies of PTO FORM 1449. It is noted that the office has not received several references from the IDS dated November 2, 2004. Those references have been lined through. If the applicant wishes the examiner to consider these references, a copy of the references should be submitted with the next correspondence.

Terminal Disclaimer

The Examiner is in agreement with the persuasive remarks submitted concerning the outstanding Double Patenting rejection over Application No. 10/050,196, now U.S. Patent No. 5,958,144 in view of which the rejection is hereby withdrawn.

Response to Arguments

Applicant's arguments with respect to claims 56-65 and 67-77 have been considered but are moot in view of the new ground(s) of rejection.

New Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 56-65 and 67-77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 56, the phrase "including" in lines 3 and 5 of the claim, renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 61, the phrase "includes" in line 2 of the claim, renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.* See MPEP § 2173.05(d).

Regarding claim 71, the phrase "including" in lines 3 and 5 of the claim, renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 73, the phrase "includes" in lines 2 and 4 of the claim, renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

The remaining claims are indefinite to the extent that they read on the rejected base claims.

New Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 56-65 and 67-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schaffer U.S. Patent No. 4,528,180 and Winston U.S. Patent No. 4,891,211.

Schaeffer teaches a multi compartment vessel having flexible side walls comprising a first component containing a gel of hydrogen peroxide and a second chamber with an alkaline pH adjusting agent (triethanolamine) (see abstract) and wherein upon squeezing the container (in response to applied pressure on the vessel), controlled quantities of each chamber are released (column 2, lines 18-26).

CARBOPOL 934 (high molecular weight crosslinked polyacrylic acid) is incorporated as a thickener (see column 4, example 1). The pH is adjusted to between 3 and 6 which

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overlaps and encompasses the claimed pH greater than 5.5 (column 3, lines 24-26). A stabilizer is disclosed (see abstract). It teaches the pH adjusting agent, triethanolamine (column 3, line 24). The amount of water in the examples is about 89% (see the examples), which meets the limitations of claim 61 (at least 70% water by weight of the mixture). Both the chambers of Schaeffer contain compositions in the form of gels (column 3, line 18) or pastes (column 3, lines 46-47).

Schaeffer differs in that it does not teach the same stabilizing agents as in instant claim 63. It is prima facie obvious to substitute equivalents, motivated by the reasonable expectation that the respective species will behave in a comparable manner or give comparable results in comparable circumstances. *In re Ruff* 118 USPQ 343; *In re Jeze* 158 USPQ 99; the express suggestion to substitute one equivalent for another need not be present to render the substitution obvious. *In re Font*, 213 USPQ 532. It would have been made obvious to one of ordinary skill in art at the time it was made to substitute the stabilizers instantly recited in claim 63 for the stabilizers recited in Schaeffer. Such a modification would have been motivated by the reasoned expectation of producing a stabilized dentifrice in a dosage delivery unit.

Regarding instant claims 67-69, drawn to a pH of the mixture, it appears that Schaeffer would adjust the pH of the mixture since the pH of the first compartment is between 3 and 6 and the second compartment is sodium bicarbonate, which is alkaline. When the two components are mixed, there would result an alkaline pH. The rejection is under 103(a) regarding these claims since the final pH is not recited in Schaeffer; however, a chemical composition and its properties are inseparable. Therefore, if the

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prior art teaches the properties applicant discloses and/or claims (i.e. a pH of 3 to 6 mixing with an alkaline sodium bicarbonate) are necessarily present. It would have been made obvious to one of ordinary skill in art at the time it was made to employ an alkaline pH in a dosage delivery unit for delivering a tooth bleaching mixture motivated by the teaching of Schaeffer who employs a first composition of hydrogen peroxide gel with a pH of 3 to 6 and a sodium peroxide paste, which is alkaline which would result in an alkaline tooth whitening mixture.

Winston teaches that sodium percarbonate is a hydrogen peroxide releasing agent (precursor) employed in a dentifrice. It is prima facie obvious to substitute equivalents, motivated by the reasonable expectation that the respective species will behave in a comparable manner or give comparable results in comparable circumstances. *In re Ruff* 118 USPQ 343; *In re Jezei* 158 USPQ 99; the express suggestion to substitute one equivalent for another need not be present to render the substitution obvious. *In re Font*, 213 USPQ 532. It would have been made obvious to one of ordinary skill in art at the time it was made to employ sodium percarbonate in a container with a dentifrice motivated by the teaching of Winston that sodium percarbonate is a safe and palatable hydrogen peroxide releasing agent (column 3, lines 30-33).

Thus the claims fail to patentably distinguish over the state of the art as represented by the cited references.

Accordingly, for the above reasons, the claims are deemed properly rejected and none are allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Correspondence

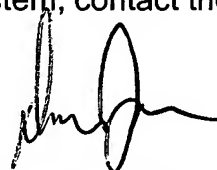
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donna Jagoe whose telephone number is (571) 272-0576. The examiner can normally be reached on Monday through Thursday from 9:00 A.M. - 3:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (571) 272-0951. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Donna Jagoe
Patent Examiner
Art Unit 1614

April 15, 2006



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